

Action sets forth a new ground of rejection that was not necessitated by Applicant's Amendment. MPEP § 706.07(a). The Office Action cites a new reference (U.S. Patent No. 5,027,336 to Sugiura) that could have been presented in the previous Office Action because Applicant's Amendment only amended claim 1 to include the limitation "without a tilt sensor input." This limitation was in originally filed claim 8 and was therefore considered by the Examiner in the previous Office Action. Because this Office Action presents the Sugiura reference for the first time to show a previously considered limitation, the Final Office Action is improper and should therefore be withdrawn.

§ 103 rejection

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,311,497 to Takizawa et al. ("Takizawa") and further in view of U.S. Patent No. 5,027,336 to Sugiura ("Sugiura"). Applicant respectfully traverses this rejection.

As explained in the February 15, 2001 Amendment, the Takizawa/Sugiura combination fails to teach the claimed invention because the control circuit in the invention avoids requiring an input from a tilt sensor to adjust a tilt angle. The Office Action asserted that "as long as Applicant needs a light detecting means to detect whether his disk is tilted or not, Applicant can not state that

his invention does not require a tilt sensor" (p. 3).

Applicant respectfully disagrees.

Applicant notes that independent claims 1, 8 and 13 do not recite a laser beam or a light detecting means as noted by the Office Action; therefore, the claimed invention is not limited to an embodiment containing these elements. The Office Action improperly states that "Applicant's invention requires a light detecting/sensing means to provide his disk's inclination information" while admitting that "Applicant does not disclose how the laser beam is detected" (p. 2). The Office Action is not permitted to read limitations and elements from the specification into the claims.

For purposes of rebutting the Office Action's arguments only, Applicant notes that the laser beam is used to detect and reproduce information on the information recording surface (specification, page 40, lines 9-20); the fact that it can also be used to detect the inclination of the optical disk (specification, page 39, lines 13-15) allows the invention to eliminate a separate tilt sensor, as explained in the February 15, 2001 Amendment.

The Office Action also admitted that "Takizawa does not disclose a motor control circuit," but asserted that "it is well known that a motor control circuit is a necessary device to control a motor" (p. 6). The Office Action also asserted that "a typical tilting mechanism

needs a control circuit because the inclination of tilting an optical pickup is [sic] cannot be manually controlled" (p. 2). Applicant respectfully disagrees.

As noted in the February 15, 2001 Amendment, the Office Action can support an inherency argument only if the disclosure offered by the Examiner is "sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function" and that the missing claimed element is "necessarily present" in the reference such that it would be recognized by persons of ordinary skill.

Finnegan Corp. v. ITC, 51 USPQ2d 1001 (Fed. Cir. 1999), quoting In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981).

Further, the Office Action is not permitted to assert that Takizawa and Sugiura can be modified to teach the claimed invention absent a suggestion or motivation to do so. See, e.g., MPEP § 2143.01, MPEP § 2144.03 (which allows Examiners to take Official Notice only of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art).

With respect to the present application, the Office Action has failed to show that the claimed control circuit is necessarily present in the Takizawa reference. Although the Examiner asserts that a motor control circuit is "well-known", the claimed motor control

circuit is not capable of instant and unquestionable demonstration as being "well-known" in the art. More particularly, a mere control circuit, without more, does not instantly and unquestionably teach a control circuit that controls tilting in the claimed manner, particularly when neither reference even mentions a control circuit as admitted by the Office Action.

The Office Action also asserted that even though various elements of the invention are not taught by Takizawa and Sugiura, they are not novel (p. 6). Applicant respectfully asserts the Office Action applies an incorrect obviousness standard. To establish a prima facie case of obviousness, MPEP § 2143 requires that "the prior art reference (or references when combined) must teach or suggest all the claimed limitations" and that "there must be some suggestion or motivation...to modify the reference or to combine reference teachings." The fact that certain claimed limitations may not be novel does not obviate the requirement for each limitation to be taught or suggested in the cited references. Because the Office Action explicitly admits that items (c) through (f) are not taught by either Takizawa or Sugiura (p. 6), the Office Action fails to establish a prima facie case of obviousness.

The Office Action also improperly took Official Notice with respect to the tilting mechanism and other electrical and mechanical components recited in the

claims, asserting that "Applicant has not disclosed that any specific parts adapted by his tilting mechanism overcome any deficiency in the prior art or as for any stated purpose" (pp. 6-7). Applicant respectfully reiterates that Official Notice applies only to facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art (MPEP §§ 2143.01 and 2144.03) and has nothing to do with what the Applicant has or has not disclosed. The Office Action's rejections that rely on Official Notice to establish obviousness should therefore be withdrawn.

Further, although the Office Action asserts that "there is a motivation to decrease the size of an optical pickup", neither Takizawa nor Sugiura remotely suggest decreasing optical pickup size. More particularly, neither reference views the optical pickup size as being relevant. Thus, any motivation to decrease the optical pickup size is speculative at best.

One of ordinary skill in the art would not have combined Takizawa with Sugiura because there is no motivation to incorporate Sugiura's tilt detection mechanism into the Takizawa device. Takizawa's structure depends on its tilt detection unit 40 and is not equipped to use the information detecting light beam itself, as shown in Sugiura, to also conduct tilt sensing function. Both Takizawa (col. 6, lines 15-28) and Sugiura (col. 6, lines 10-40) simply assume that the tilt

is adjusted based on their respective tilt detector outputs, but the differences in the types of outputs each reference processes, along with the sparse teachings of each reference with respect to tilt adjustment based on the signals, makes combination of the two references unobvious. The Office Action therefore fails to establish a *prima facie* case of obviousness. Withdrawal of the rejection of claims 1-20 is therefore respectfully requested.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited.

Any fees associated with the filing of this paper should be identified in any accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC.

Respectfully submitted,

Dated:



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